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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,872	03/12/2001	William Coan	12177/44301	5649

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KENYON & KENYON  
1500 K STREET, N.W., SUITE 700  
WASHINGTON, DC 20005

EXAMINER

ESCALANTE, OVIDIO

ART UNIT PAPER NUMBER

2645

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/802,872

Applicant(s)

COAN ET AL.

Examiner

Ovidio Escalante

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. This action is in response to applicant's amendment filed on July 6, 2004. **Claims 1-28** are now pending in the present application.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,2,12,13,24,25 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Dusse US Patent Pub. 2002/0068554.

**Regarding claim 1**, Dusse teaches a method for providing enhanced features at a mobile communication device, (abstract; paragraph 0011), the device including a feature (software applications, phone features, services - fig. 2) having a set of sub-features, (voicemail, email, address book, call forwarding, billing; paragraphs 0006 and 0011), comprising:

receiving, from a user at the mobile communication device, a request for one of the sub-features, (paragraphs 0011, 0042 and 0043);

searching the mobile communication device for the requested sub-feature, (paragraphs 0036 and 0040);

searching an enhanced local services server for the requested sub-feature, if the requested sub-feature is not resident of the mobile communication device, , (paragraphs 0011, 0037 and 0042);

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accessing the requested sub-feature from the enhanced local services server, (paragraphs 0033 and 0043); and

receiving the requested sub-feature at the mobile communication devices via a wireless channel, (paragraphs 0032-0033, 0042 and 0043).

**Regarding claim 2**, Dusse, in view of claim 1, teaches wherein said wireless channel comprises a digital control channel, (paragraphs 0037 and 0043).

**Regarding claim 12**, Dusse teaches a method for provisioning services to a mobile communication device, (abstract; paragraphs 0011 and 0047), comprising:

programming the mobile communication device to provide a first set of features (516-fig. 5) defining an aspect of a first service, (fig. 2; paragraphs 0011 and 0037; fig. 5 - 516);

programming a wireless network server to provide a second set of features, (542-fig. 5; paragraphs 0011 and 0043),

supplementing said first set, to fully define said first service, (paragraph 0033);

receiving, at the mobile communication device, a command to access said first service, (paragraphs 0032 and 0033);

responsive to said command, determining whether said first set of features can satisfy said command, (paragraphs 0032-0033, 0042 and 0043); and

if it is determined that said first set of features cannot satisfy said command then automatically transmitting a request to satisfy said command to said wireless network server, (paragraph 0033).

**Regarding claim 13**, Dusse, as applied to claim 12, teaches wherein the request to satisfy said command is transmitted via a wireless digital control channel, (paragraphs 0037 and 0043).

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**Regarding claim 24**, Dusse teaches a system for providing service features to a mobile communication subscriber, (abstract; paragraph 0011) comprising:

a mobile communication network, (fig. 1);

a mobile network services server coupled to said mobile communication network, (figs. 1 and 4); and

a mobile communication device coupled to said mobile communication network via an over-the-air transmission path, (figs. 1 and 3), said mobile communication device including,

a processor, (fig. 3; paragraph 0037); and

a memory coupled to said processor (fig. 3; paragraph 0037) and storing therein a program to perform the operations of, generating a command for a communication service based on a subscriber inputs, (paragraphs 0011 and 0032);

determining whether said communication service can be satisfied by the mobile communication device as a stand alone device, and if it is determined that said mobile communication device cannot satisfy said communication service, then automatically transmitting a service request to said mobile network services server via said over-the-air transmission path, (paragraphs 0032-0033, 0042 and 0043).

**Regarding claim 25**, Dusse, as applied to claim 24, teaches wherein said over-the-air transmission path comprises a wireless digital control channel, (paragraphs 0037 and 0042).

**Regarding claim 28**, Dusse, as applied to claim 24, teaches wherein said communication service relates to a personal information management service, (paragraph 0011).

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 3-7, 19 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dusse in view of Marwell et al. US Patent 6,668,055.

***Regarding claim 3***, while Dusse, in view of claim 1, teaches of a feature defines a resident address book service which is stored at the mobile communication device and of

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provisioning resident features in a mobile communication device, Dusse does not specifically teach of the sub-feature defines an address book.

However, Dusse suggests the features may include a plurality of different services and features and allowing a user to select features that is used for the device, therefore it would have been obvious to include an address book so that the mobile device can be provisioned with features that are not initially provisioned in the device.

Nonetheless, Marwell teaches wherein a superset of features defines an address book service in the network and wherein a subset of features defines a portion of a user-defined address book to be stored at the mobile communication device, (col. 5, lines 24-51; col. 6, lines 3-52; the network stores the master copy (superset) of the address book and when the network address book is modified then the address book in the mobile device (portion of the address book) can be allow to receive the full modified address book from the network).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the provisioning service of Dusse to include an address book service in the network to be used by the device as suggested by Marwell so that the users address book can be provisioned to multiple telephony devices and all address books can easily be synchronized with the desired contact numbers.

**Regarding claim 4**, Dusse, in view of claim 3 and as modified by Marwell teach wherein the received request comprises a request for access to a portion of said user defined address book which is stored in the wireless network, (col. 5, lines 24-41, col. 6, lines 32-52; col. 11, lines 37-52).

**Regarding claims 5 and 7**, Dusse, in view of claim 4, teaches wherein said wireless channel comprises a digital control channel, (paragraphs 0037 and 0042).

**Regarding claim 6**, Dusse, in view of claim 4 and as modified by Marwell, further teach receiving an update transmission from said mobile communication device to effect a modification of said user defined address book stored in the wireless network, (col. 5, lines 24-51 col. 6, lines 32-52).

**Regarding claims 19 and 27**, Dusse, in view of claim 12 and 24, does not teach the first service/communication service being an address book, however as explained above, it would have been obvious to include an address book based on the suggestion of storing a resident address book and provisioning resident features as suggested by Dusse.

Marwell, as shown above teaches that it was well known to have a first service to include an address book and to have a second service which also includes an address book in the network, (col. 5, lines 24-51; col. 6, lines 3-52).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the provisioning service of Dusse to include an address book service in the network to be used by the device as suggested by Marwell so that the users address book can be provisioned to multiple telephony devices and all address books can easily be synchronized.

8. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dusse in view of Marwell and further in view of Calder et al. US Patent Pub 2001/0034244.

**Regarding claims 20 and 21**, while Dusse in view of Marwell, as applied to claim 19, teaches of having address books in the network and in the mobile communication device, Dusse



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in view of Marwell do not specifically teach of having the address book comprise different portions.

Calder teaches that it was well known in the art to store a first portion of an address book in a mobile terminal (paragraphs 0007,9,0058,0077-0078) and to store second portion of an address book in a server so that a user can request the second portion of the address book on a as needed basis, (paragraphs 0007,0064-0065).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Dusse and Marwell by having two different portions of address books as suggested by Calder so that a user can individually select from a list of numbers a specific list (e.g. fone list A, fone list B) that the users needs at that time while ensuring that the phone list will fit thee phone books memory.

**Regarding claim 22**, Dusse, as applied to claim 21, teaches wherein said mobile communication device queues said command and performs said step of transmitting when a communication path to said wireless network server becomes available, (paragraphs 0032-0033).

**Regarding claim 23**, Dusse, as applied to claim 22, teaches wherein the request to satisfy said command is transmitted via a wireless digital control channel, (paragraphs 0037 and 0042).

9. Claims 8-11,14-18 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dusse in view of Kahan et al. US Patent Pub. 2002/0024536.

**Regarding claim 8**, while Dusse, in view of claim 1, teaches of providing a plurality of features for the mobile communication device, Dusse does not specifically teach of defining a calendar service.

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Kahan teaches that it was well known in the art to have a calendar service stored in the network and to send the calendar to the mobile device. Kahan also teaches wherein a feature defines a calendar service and wherein said set of sub-features defines a portion of a user defined calendar to be stored at the mobile communication device, (paragraphs 0006 and 0058).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Dusse to include a calendar service to be included in the provisioning so that the mobile communication device can be provisioned with services that the user desires.

*Regarding claims 9,11,14-16 and 26,,* Dusse as modified by Kahan in view of claims 8, 12 and 24, teach wherein said received request comprises a request for access to a portion of said user defined calendar which is stored in the wireless network, (paragraphs 0006 and 0058, Kahan);

receiving an update transmission from said mobile communication device to effect a modification of said user defined calendar stored in the wireless network, (paragraphs 0006 and 0058, Kahan);

wherein said first service/communication service comprises a calendar service having a plurality of scheduling options, (paragraphs 0006 and 0058);

wherein said aspect of the first service comprises a monthly scheduler capable of handling a subset of the scheduling options in the calendar service, (paragraphs 0006 and 0058);  
and

wherein said command requests to schedule an event outside of the scheduling options available with said aspect of the first service.

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As stated above it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Dusse to include a calendar service to be included in the provisioning so that the mobile communication device can be provisioned with services that the user desires.

***Regarding claim 10***, Dusse, as applied to claim 9, teaches wherein said wireless channel comprises a digital control channel, (paragraphs 0037 and 0042).

***Regarding claim 17***, Dusse, as applied to claim 16, teaches wherein said mobile communication device queues said command and performs said step of transmitting when a communication path to said wireless network server becomes available, (paragraphs 0032-0033).

***Regarding claim 18***, Dusse, as applied to claim 17, teaches wherein the request to satisfy said command is transmitted via a wireless digital control channel, (paragraphs 0037 and 0042).

#### ***Response to Arguments***

10. Applicant's arguments filed July 6, 2004 have been fully considered but they are not persuasive.

***Regarding claim 1***, Applicant contends that Dusse treats services and features separately and Dusse does not contemplate a method for providing enhanced features at a mobile communication device, the device including a feature having a set of sub-features. The Examiner respectfully disagrees.

Since independent claim 1, does not specify what is considered to be a feature, the Examiner has read feature to be the main selection header that will access all available features as shown in figure. 2. The selection of a main section will allow a user to select individual features or services (sub-features) so that their mobile phone can have the requested services. For

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example, Dusse teaches that some of the sub-features can be call forwarding, voicemail, address book and email. Therefore, the Examiner believes that Dusse teaches of having a feature comprising a set of sub-features as shown in claim 1.

**Regarding claim 12**, Applicant contends that Dusse does not teach or suggest programming the mobile communication device to provide a first set of features defining an aspect of a first service; programming a wireless network server to provide a second set of features supplement said first sent, to fully define said first service. The Examiner respectfully disagrees.

As shown above, the broadly recited term “features” reads on e.g. “Phone features” as shown in figure 2 and the first set of features are as shown throughout the Dusse Patent to include a plurality of different services such as address book, email, voicemail, call forwarding and billing. The network server stores the fully defined version of each service that is contained in the mobile phone and will provision the mobile phone with the service and features upon receiving a request from the user.

**Regarding claim 24**, Applicant contends that Dusse does not teach determining whether said communication service can be satisfied by the mobile communication devices as a stand alone device. The Examiner respectfully disagrees.

The mobile device of Dusse provides for the provision of services and features of the telephone. Initially the server determines that most of the communication services or features cannot be satisfied by the mobile device as a stand alone device and if the user wants to use the features and services of the mobile device the user must make a request for desired services and features. When a user makes a request, all of the selections that will shown in the provisioning

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screen are determined to be services and features that the user can have on their phone.

Therefore, once the user selects the appropriate features and services then it is determined that the mobile device can act as a stand-alone device.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

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Hand-delivered responses should be brought to:

220 20<sup>th</sup> Street S.  
Crystal Plaza two, Lobby, Room 1B03  
Arlington, VA 22202

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 703-308-6262. The examiner can normally be reached on M-F (6:30AM - 5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**OVIDIO ESCALANTE**  
**PATENT EXAMINER**

*Ovidio Escalante*

Ovidio Escalante  
Examiner  
Group 2645  
November 1, 2004

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